



29 SEP 2006

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In re Application of  
ZENG et al.

Application No.: 10/533,623

PCT No.: PCT/CN03/00917

Int. Filing Date: 29 October 2003

Priority Date: 31 October 2002

Attorney Docket No.: 09548.1000USWO

For: A OPTICAL BIOPSY METHOD FOR  
PRECANCEROUS LESION DIAGNOSIS AND  
AN ENDOSCOPE APPARATUS THEREOF

DECISION ON REQUEST

UNDER 37 CFR 1.497(d)

This is a decision on applicants' "Renewed Petition under 37 CFR 1.497(d)", filed on 07 June 2006 in the United States Patent and Trademark Office (USPTO). Petitioner seeks to add Zhouran Huang as inventor in the above referenced application. The requisite \$130 petition fee was paid.

### BACKGROUND

On 07 December 2005, a Notification of Missing Requirements was mailed indicating that an oath or declaration, in compliance 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date, was required.

On 20 January 2006, applicant filed a request to correct the inventorship, to add Zhouran Huang as an inventor. In addition to the \$130 petition fee, Petitioner provided the statement of Zhouran Huang in support of the correction of inventorship under 37 CFR 1.497(d) and a declaration executed by the joint inventors along with the \$65 surcharge for filing the declaration after the thirty month period.

On 11 April 2005, a decision was mailed to applicant indicating that applicant has not provided a Written Consent of Shanghai Shengbio Science and Technology Co., Ltd. (assignee) to correct the inventorship under 37 CFR 1.497(d)(3) consenting to the addition of Zhouran Huang as an inventor in this application.

On 7 June 2006, applicant responded with a statement from representative of assignee.

### DISCUSSION

Where the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and 37 CFR 1.497(d) names an inventive entity different from the inventive entity set forth in the international

application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor that any error in inventorship occurred without deceptive intention on his or her part; (2) the fee set forth in § 1.17(I); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee(s).

Applicants previously satisfied Items (1) and (2) above.

With regard to Item (3), applicant provided a Written Consent of Shanghai Shengbio Science and Technology Co., Ltd. (assignee) to correct the inventorship under 37 CFR 1.497(d)(3) consenting to the addition of Zhouran Huang as an inventor in this application. However, this statement was signed by Zhouran Huang, identified as *representative for Shanghai Shengbio Science and Technology Co., Ltd.* The submission establishing ownership by the assignee must be signed by a party who is authorized to act on behalf of the assignee. It is not clear from the written consent that Mr. Huang has such authority.

The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization. An officer (chief executive officer, president, vice-president, secretary, or treasurer) is presumed to have authority to sign on behalf of the organization. The signature of the chairman of the board of directors is acceptable, but not the signature of an individual director. Modifications of these basic titles are acceptable, such as vice-president for sales, executive vice-president, assistant treasurer, vice-chairman of the board of directors. In foreign countries, a person who holds the title "Manager" or "Director" is normally an officer and is presumed to have the authority to sign on behalf of the organization. A person having a title (administrator, general counsel) that does not clearly set forth that person as an officer of the assignee is not presumed to have authority to sign the submission on behalf of the assignee. A power of attorney to a patent practitioner to prosecute a patent application executed by the applicant or the assignee of the entire interest does not make that practitioner an official of an assignee or empower the practitioner to sign the submission on behalf of the assignee. The submission may be signed by any person, if the submission sets forth that the person signing is authorized (or empowered) to act on behalf of the assignee, i.e., to sign the submission on behalf of the assignee. 37 CFR 3.73(b)(2)(I). The submission may be signed by a person empowered by an organizational resolution (e.g., corporate resolution, partnership resolution) to sign the submission on behalf of the assignee, if a copy of the resolution is submitted in the record.

Item (3) above has not yet been satisfied.

Accordingly, applicant has not met all of the requirements to add Zhouran Huang as co-inventor in the above-identified international application.

### CONCLUSION

For the reasons discussed above, the submission under 37 CFR 1.497(d) to add Zhouran Huang as co-inventor is hereby DISMISSED WITHOUT PREJUDICE.

The application will be held in the PCT Legal Office to await applicant's further reply.

Any reconsideration on the merits of the renewed petition under 37 CFR § 1.497(d) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR § 1.497(d)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail

Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

  
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